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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,160

04/08/2004

Gary Vanc Anderson

19,249

2961

23556 7590 03/07/2007  
KIMBERLY-CLARK WORLDWIDE, INC.  
401 NORTH LAKE STREET  
NEENAH, WI 54956

EXAMINER

FORTUNA, JOSE A

ART UNIT

PAPER NUMBER

1731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/822,160

Applicant(s)

ANDERSON ET AL.

Examiner

José A. Fortuna

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/26/04</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to a "Multi-ply Tissue," classified in class 162, subclass 124.
  - II. Claims 15-19, drawn to a "Method of manufacturing," classified in class 156, subclass 209.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method as claimed can be used to make a materially different product, such as one in which the additive resides in the upper side of the crimping depression, but the depression is not concave in shape, i.e., point like depression, square depression, etc.
  3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
  4. During a telephone conversation with Scott Baum on March 1, 2007 a provisional election was made without traverse to prosecute the invention of group I, claims 1-14.
- Affirmation of this election must be made by applicant in replying to this Office action. Claims

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15-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Drawings*

6. The drawings are objected to because reference numeral **30** in figure 1, while being described in the specification as the nip between rolls **20** and **26**, page 5, lines 3-4, is pointing to the internal surface of roll **26**. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 5-6 and 11-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Krzysik et al., WO 01/47699 A1.

Krzysik et al. teach a multi-ply tissue which is treated with a chemical additive and then crimped and/or embossed to join the plies, see abstract. Krzysik et al. teach that the additive or additives can be added either to the outer layers, if it is desired that the additive(s) comes/come in contact with the user or to the inner layer if not, see page 8, lines 6-21; see lines 17-21 for the teaching of the using of the inner plies surface. Also Krzysik et al. teach the Additive to be antibacterial/antiviral, see page 8, lines 19-21 and page 12, line 27 through page 14, line 11. Krzysik et al. show the use of a crimping and anvil roll for crimping the plies on page 4, lines 8-19 and page 18, lines 9-31 and teach the ply attachment strength within the claimed range, see example 5 which shows crimp strength of 40.5 grams. The use of polysiloxane is disclosed on page 16, lines 2-23.

It seems that Krzysik et al. teach all the limitations of the above claims or at least the minor modification(s) to obtain the claimed invention would have been obvious to one of ordinary skill in the art.

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1-3, 5-6 and 11-14 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Krzysik et al., US Patent No. 6,544,386, (cited in the ids filed on July 26, 2004).

Krzysik et al. teach a multi-ply tissue which is treated with a chemical additive and then crimped and/or embossed to join the plies, see abstract. Krzysik et al. teach that the additive or additives can be added either to the outer layers, if it is desired that the additive(s) comes/come in contact with the user or to the inner layer if not, see column 4, line 60 through column 5, line 10; see lines 5-10 of column 5 for the teaching of the using of the inner plies surface. Also Krzysik et al. teach the Additive to be antibacterial/antiviral, see column 5, lines 5-10 and column 7, line 25 through column 8, line 11. Krzysik et al. show the use of a crimping and anvil roll for crimping the plies on column 2, lines 55-67 and column 10, line 1-37 and teach the ply attachment strength within the claimed range, see example 5 which shows crimp strength of 40.5 grams. The use of polysiloxane is disclosed on column 9, lines 4-67.

It seems that Krzysik et al. teach all the limitations of the above claims or at least the minor modification(s) to obtain the claimed invention would have been obvious to one of ordinary skill in the art.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 4 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik et al. in both references cited above.

Krzysik et al. do not explicitly teach the use the virucidal agent as claimed in claim 4. However the use of surfactants in a mixture with carboxylic acids, such as citric and malic acid, as virucidal agent is very well known in the art, see for example WO 01/492,59 A2, or US Patent Nos. 4,738,847; 4,897,304, just to mention a few. Therefore, the use of the claimed surfactant and carboxylic acid virucidal agent would have been obvious to one of ordinary skill in the art, since he or she would have reasonable

expectation of success if such well known virucidal agent were used in the tissue of the cited references. Note that it has been held that “[W]here two equivalents are interchangeable for their desired function, substitution would have been obvious and thus, express suggestion of desirability of the substitution of one for the other is unnecessary.” *In re Fout* 675 F. 2d 297, 213 USPQ 532 (CCPA 1982); *In re Siebentritt*, 372 F.2d 566, 152 USPQ 618 (CCPA 1967).

As to the shape of the crimping protuberances, this is also very well known in the art, and therefore choosing a determined protuberance to form an specific pattern or to optimize the chemical additive retention would have been obvious to one of ordinary skill in the art.

As to the ratio of strength of the first and second side this is either inherent to the cited reference(s), since they teach the same tissue, crimped in similar manner and with the application of additive in the same range as disclosed, (not claimed), or at least optimizing such property is within the levels of ordinary skill in the art. Note that it has been held that “[T]he discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art. *In re Antoine*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); *In re Aller*, 42 CCPA 824, 220 F.2d 454, 105 USPQ 233 (1995).

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of “Multi-ply Tissues.”

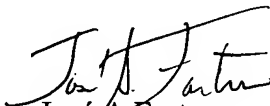


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
José A Fortuna  
Primary Examiner  
Art Unit 1731

JAF